



DICKSTEIN SHAPIRO LLP
1633 Broadway
NEW YORK NY 10019

MAILED

MAR 23 2010

OFFICE OF PETITIONS

In re Application of	:	
Igakura	:	
Application No. 09/960,548	:	DECISION
Filed: 20 September, 2001	:	
Attorney Docket No. P/1866-65	:	

This is a decision on the petition, filed on 22 March, 2010, and considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition under 37 C.F.R. §1.181 is **GRANTED**.

As to the Request to Withdraw
the Holding of Abandonment

Petitioners always are directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness requirements for relief under 37 C.F.R. §1.181.

BACKGROUND

The record reflects as follows:

The history of this matter is long-troubled and marked by Petitioners now-repeated failure to comply with, *inter alia*, the guidance in the Commentary at MPEP §711.03(c)

Previously:

Petitioner failed to reply timely and properly Notice of Noncompliant Appeal Brief mailed on 21 December, 2006, with reply due absent extension of time on or before Monday, 22 January, 2007. The application went abandoned by operation of law after midnight 22 January, 2007. The Office mailed the Notice of Abandonment on 31 July, 2007. On 13 June, 2008, Petitioner filed a

petition, asserting, *inter alia*, that the Notice of Noncompliant Appeal Brief was not received, a search of the file and non-discovery, and provides statements by Petitioner and Ms. Henrietta Marron, who is averred to docket materials received in the mail from the Office, and a due-date docket calendar for 21 January, 2007. However, in view of the fact that the due date was a non-business day (a Sunday) and the next day was the last date for reply—and thus the reply due-date—there was no showing as to the calendar for that date and it does not appear that Petitioner included a copy of the docket sheet/file jacket cover for the instant application. Moreover, the Office mailed the Notice of Abandonment on 31 July, 2007, and under the rule (37 C.F.R. §1.181), Petitioner had two (2) months to seek relief from the act complained of, which timeliness requirement Petitioner failed to satisfy with the instant petition filed nearly eleven (11) months after the Notice of Abandonment. The petition was dismissed on 5 September, 2008. On 22 September, 2008, Petitioner filed a petition pursuant to 37 C.F.R. §1.137(b), which was granted on 28 November, 2008.

Thereafter:

On 6 March, 2009, the Office re-mailed the Notice of Non-Compliant Amendment, and, the record indicates, Petitioner filed an Amended Brief on 6 April, 2009.

On 8 April, 2009, following a 6 April, 2009, Interview, the Examiner mailed an Interview Summary noting therein that “applicant will clarify the mapping of the limitations in an amended appeal brief.”

On 8 May, 2009, Petitioner submitted a post-summary “Statement of Substance”

On 23 October, 2009, the Office mailed a Notice of Abandonment.

Thereafter, Petitioner’s first petition of 22 December, 2009, was dismissed on 8 March, 2010, for failing to make a sufficient showing pursuant to 37 C.F.R. §1.181 and consistent with the guidance in the Commentary at MPEP §711.03(c)(I).

On 22 March, 2010, Petitioner re-submitted his petition and pointed expressly to the element at page 2 of Petitioner’s 8 May, 2009, submission wherein Petitioner stated “*** Applicant refiled the Appeal Brief on April 6, 2009[,]” and so expressly replied to the 8 April, 2009, requirement of the Examiner by pointing out the location of the substantive response, which was filed immediately following the Interview of 6 April, 2009.

The guidance in the Commentary at MPEP §711.03(c)(I) provides in pertinent part:

37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit

of the correspondence as “Express Mail.” A petition to withdraw the holding of abandonment relying upon a timely reply placed in “Express Mail” must include an appropriate petition under 37 C.F.R. §1.10(c), (d), (e), or (g) (see MPEP §513). When a paper is shown to have been mailed to the Office using the “Express Mail” procedures, the paper must be entered in PALM with the “Express Mail” date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP §503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. 1.8(b) and MPEP §512. As stated in 37 C.F.R. §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).

37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. §1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP §512.¹

¹ See: MPEP §711.03(c) (I)(B).

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (*see*: 37 C.F.R. §1.181(f)), and those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).

Allegations as to the Request to Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how it is to be made and supported.

Petitioner appears to have made the showing required.

CONCLUSION

Accordingly, the petition as considered pursuant to 37 C.F.R. §1.181 is **granted** and the 23 October, 2009, Notice of Abandonment is **vacated**.

The instant application is released to Technology Center/AU 2161 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2³) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.